THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte L. HANS-ERIK LARSSON,
DIETER EICKELER and JORG REINE

Appeal No. 96-0354
Application No. 08/099,066[1]

ON BRIEF

Before CALVERT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

[1] Application for patent filed July 27, 1993.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16, which are all of the claims pending in this application.[2]

We REVERSE.

[2] Claim 1 was amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a method and device for web cutting in the former of a paper machine. An understanding of the invention can be derived from a reading of exemplary claims 1 and 8, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Heys	2,857,822	Oct. 28, 1958
Miyamoto	3,556,936	Jan. 19, 1971
Peterson	3,652,390	Mar. 28, 1972

Claims 1 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Peterson in view of Miyamoto.

Claims 6, 7, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Peterson in view of Miyamoto as applied above, and further in view of Heys.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed July 13, 1995) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 14, filed June 1, 1995) for the appellants' arguments thereagainst.[3]

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification[4] and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it

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[3] The rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, and the rejection of claims 1-16 under 35 U.S.C. § 103 utilizing Nykopp as the primary reference have been withdrawn by the examiner (see the Advisory Action (Paper No. 10, mailed March 14, 1995) and section (4) of the answer).

[4] The appellants have proposed an additional drawing (Figure 2) which has been approved by the examiner in the Advisory Action. In accordance with 37 CFR § 1.74, the appellants should amend the brief description of the drawings (specification, p. 4) to refer to Figure 2.

is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 16 under
35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of

ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the rejection of the independent claims on appeal (i.e., claims 1 and 8).

The examiner determined (answer, p. 3) that

> Peterson teaches a twin wire former wherein sharp edges are defined by use of on [sic, one] wire having impermeable bands 30. Peterson on col. 1 lines 13-25 and col. 4 lines 10-15 teaches that separating the edges by a thin jet of water is known, but that the band 30 is an

> improvement thereover. Thus to use a thin jet of water instead of the solution taught by Peterson would have been prima facie obvious to one of ordinary skill in the art, and to use such jet cutters on the forming roll location would have been prima facie obvious, as this is where impermeable bands 30 are used, and especially since Miyamoto teaches the use of a water jet nozzle 10 on a roll to trim paper edges. Miyamoto is seen to provide motivation to use known water trim nozzles against a roll.

The appellants argue (brief, pp. 6-10) that the subject matter of claims 1 and 8 would not have been suggested by the teachings of Peterson and Miyamoto. We agree for the reasons set forth below.

We agree with the examiner that there is sufficient motivation in the combined teachings[5] of Peterson and Miyamoto to have suggested providing a twin wire former with a downstream water jet cutter to trim the edges of the paper web.[6] However, we see no teaching or motivation in the

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[5] The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

[6] This only results in a twin wire former that the appellants have admitted (specification, pp. 1-2) is known in

teachings of the applied prior art that would have suggested to one of ordinary skill in the art at the time the invention was made to locate the water jet cutter at the forming roll where the paper web and the inner and outer fabrics together wrap the forming roll in a sandwich structure. Instead, it appears to us that the examiner relied on impermissible hindsight in reaching his obviousness determination. In our view, the teachings of Peterson and Miyamoto relied upon by the examiner as suggesting locating the water jet cutter at the forming roll are only sufficient when combined with impermissible hindsight.

Since all the limitations are not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 1 and 8, and of dependent claims 2 through 7 and 9 through 16.[7]

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the art.

[7] We have also reviewed the Heys reference additionally applied in the rejection of dependent claims 6, 7, 15 and 16 but find nothing therein which makes up for the deficiencies of Peterson and Miyamoto discussed above regarding claims 1 and 8.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 16 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)	

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APPEAL NO. 96-0354 - JUDGE NASE
APPLICATION NO. 08/099,066

APJ NASE

APJ CRAWFORD

APJ CALVERT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 03 Nov 98

FINAL TYPED: